

REMARKS

The above-referenced application has been reviewed in light of the Examiner's Office Action dated March 3, 2006. Claims 20-39 are currently pending in this application. The Examiner's reconsideration of the rejections is respectfully requested, particularly in view of the above amendments and the following remarks.

In accordance with the Office Action, Claims 20, 27 and 34 stand rejected under 35 USC § 103(a) as being unpatentable over Non-Patent Document: "Supporting Ranked Boolean Similarity Queries in MARS", IEEE Trans. on Knowledge and Data Engineering, 10, Nov-Dec. 1998, Authors: Ortega et al.; in view of Non-Patent Document: "MediaNet: A Multimedia Information Network for Knowledge Representation", In Conference on Internet Multimedia Management Systems, Vol. 4210, pages 1-12, Boston, MA, Nov. 2000, 1 ST/SPIE.00, Authors: Ana B. Benitez-Jimenez, Chung-Sheng Li, and John R. Smith. Applicants respectfully traverse.

As correctly indicated by the Examiner, the Ortega et al. publication fails to teach or suggest "transferring the low-level query to one or more search engines" as recited in pending Claims 20 and 27, and similarly in pending Claim 34. The Examiner relies on the MediaNet publication to cure the deficiencies of Ortega et al. Such reliance is misplaced.

The MediaNet publication was published on November 6, 2000 by three co-authors, two of whom are co-inventors of the presently pending application and claims. U.S. Provisional Patent Application Serial No. 60/246,052 was filed on the same date of November 6, 2000 to fully protect the subject matter of the MediaNet publication. Thus,

the present application shares two co-inventors with both the provisional application and the protected publication, namely Chung-Sheng Li and John R. Smith. In addition, the inventions of both the present application and the provisional application have been subject to continuing duties of assignment to the same assignee, namely International Business Machines ("IBM") Corporation. The present non-provisional application is covered by an assignment of record to IBM, which has been duly recorded in the United States Patent and Trademark Office at Reel 012067, Frame 0538.

In a Rule 131 Declaration executed on March 16, 2004, which is currently of record in this case, co-inventor Chung-Sheng Li affirmed that he and co-inventor John R. Smith had conceived the portions of the MediaNet subject matter that were used to support the rejections in the Office Action dated December 16, 2003, and that they had not abandoned, suppressed or concealed the subject matter of the present application from the date of conception, at least as early as November 6, 2000, to the date of constructive reduction to practice, at least as early as August 9, 2001.

The Examiner's underlying basis under 35 U.S.C. § 102 for the § 103(a) rejections of the presently pending claims has not been divulged to Applicants. The subject matter of the MediaNet publication and corresponding U.S. Provisional Application is Applicants' own invention, and therefore unavailable under § 103(a) where the underlying § 102 basis would rest on invention by another. In addition, the subject matter of the MediaNet publication and corresponding U.S. Provisional Application is subject to a duty of assignment to the same assignee as the present application, and therefore unavailable under § 103(a) by operation of § 103(c). Thus, by

a process of elimination, the Examiner's underlying § 102 basis for the § 103(a) rejections may be that the Examiner believes that Applicants disclosed the subject matter of their invention more than one year prior to their regular filing date.

Unfortunately, this theory is not supported by the facts, particularly since the MediaNet reference on which the Examiner relies was published less than one year prior to Applicants' regular filing date.

In order to expedite the prosecution of this case, the specification has been amended to recite a claim for priority to Applicants' U.S. Provisional Application under § 119(e)(1). The Examiner is encouraged to accept the unintentionally delayed submission of an amendment under this subsection, particularly where Applicants did not receive timely notice of the Examiner's underlying § 102 basis for rejections under § 103(a). Should the Examiner determine that a surcharge is required in order to enter the unintentionally delayed amendment, the Examiner is hereby authorized to charge such surcharge to deposit account number 50-0510 / IBM (Yorktown Heights).

Thus, the MediaNet publication is either unavailable and/or removed as a reference for the purposes of 35 USC § 103(a). Therefore, the recitations of Applicants' currently pending Claims 20, 27 and 34 are neither taught nor suggested by Ortega et al., whether taken alone or in combination with any of the other properly available references of record in this case.

Conclusion

Accordingly, it is respectfully submitted that independent Claims 20, 27 and 34 are in condition for allowance for at least the reasons stated above. Since Claims 21-26, 28-33 and 35-39 each depend from one of the above claims and necessarily include each of the elements and limitations thereof, it is respectfully submitted that these claims are also in condition for allowance for at least the reasons stated, as well as for reciting additional patentable subject matter. Thus, each of Claims 20-39 is in condition for allowance. All issues raised by the Examiner having been addressed, reconsideration of the rejections and an early and favorable allowance of this case are earnestly solicited.

Respectfully submitted,

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